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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,088	02/24/2000	Koichi Horikawa	Q57985	5415

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EXAMINER
WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 11/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/512,088	HORIKAWA, KOICHI	
	Examiner	Art Unit	
	Michael Y Won	2155	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)] .

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached response*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-11*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *Interview Summary attached*

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER

Response to Arguments

1. In response to the argument of claim 1, clearly the limitation of "determining... whether **or not**" (emphasis added) is clearly inherent. When any server cannot resolve an address, the packet is inherently dropped. Williams teaches of maintaining "a database of all network layer address space in its domain" (see pg.2/4, 5th paragraph). However, as the client's IP frame is forwarded to the network and the router server is queried (see pg.2/4, 8th paragraph), one of ordinary skill in the art would conclude that if the router server will not be able to resolve a proxy ATM address, the packet will inherently be dropped. Since Williams teaches, "MPOA is 'connection oriented'... before a conversation between two users can commence, a dedicated switched path (or circuit) is established between them across the network's switching fabric. One can look at a typical telephone system for analogy. If a telephone number is dialed and the phone number is unrecognizable by the switching center, inherently a path will not be established to that number.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "undesired packets are discarded and not forwarded anywhere" last sentence of argument on page 3 to 4 and "cannot determine a shortcut is undesirable" on page 4, line 6) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is agreed that Williams explains "the conventional MPOA over an ATM network", however the limitations of claim 1, also broadly suggest the same.

2. In response to the argument regarding claim 2, specifically that Williams teaches of IP addresses and not addresses, clearly the teachings of Williams is more specific therefore, the element of address could in fact include IP addresses.

Williams teaches on page 2/4, on paragraphs 3 and 4 respectively, "The desktop computers will be speaking a conventional Layer 3 protocol like IP or IPX. The edge switch will receive an IP frame (for example) with appropriate source and destination addresses" and "process of mapping IP destination address to a proxy ATM destination address is generally referred to as address resolution". Williams also teaches on page 2/4, paragraph 8, "All subsequent packets with the same IP destination address will be sent on this ATM path. In effect we have an ATM switched path performing high speed forwarding between two IP subnets". Clearly the combinations of teachings above implicitly teach of an extension to the address resolution packet in implementing a shortcut.

3. In response to the argument regarding claim 6, Williams clearly teaches of a server "The MPOA server, or route server" and not of a "black box" as presumed to be by the applicant and/or applicant's representative.

4. Finally, in response to the argument of claim 11, see the response regarding claim 2 above. Furthermore, Williams teaches of forwarding an address request packet to allow a device incapable determining to communicate the packet with a client (see page 2/4, 8th paragraph).

5. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a **general allegation** that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

6. In view of the above, the independent claims need to be amended to clearly define the functional novelty that which the applicant regards as his/her invention. Claims 1, 6, and 11 are not in a condition for allowance.

Michael Y Won

November 9, 2004

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